

REMARKS

Claims 1-9 are pending in the application.

Claims 1-9 have been rejected.

Claims 1-5 and 7-9 have been amended, as set forth herein.

I. CLAIM OBJECTIONS

Claims 3 and 4 were objected to because of informalities. Claims 3 and 4 have been amended for correction.

II. REJECTION UNDER 35 U.S.C. § 102

Claims 1-4 and 7-8 were rejected under 35 U.S.C. § 102(e) as being anticipated by Zaki (US Patent No. 7,164,915). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

To further prosecution, independent Claims 1, 3 and 7 have been amended to recite “receiving from the first access point the roaming candidate list identifying the plurality of candidate access points in the WLAN.” Independent Claim 5 has been amended to recite “wherein the roaming candidate list identifying the plurality of candidate access points in the WLAN is received from the first access point.” Original independent Claim 9 includes “the access points in a first cell are operable for transmitting a roaming candidate list to a mobile device associated with one of the access points in the first cell, the list identifying one or more neighborhood access points.”

The Office Action argues that Zaki discloses “receiving from the first access point the roaming candidate list identifying the plurality of candidate access points in the WLAN,” citing Zaki, Col. 3, lines 50-51. For ease of reference, this portion of Zaki is set forth below in its entirety:

A list of neighbor BSSs 12 is determined, step S62, and a scan neighbor routing is initiated, step S64.

Clearly, the cited portion fails to disclose or describe that the roaming candidate list identifying the plurality of candidate access points in the WLAN is received from the first access point. Zaki merely describes that a list of neighbor BSSs 12 is determined - nothing more. No teaching of receiving such a list from the access point is found in Zaki. In fact, another portion of Zaki supports the only reasonable conclusion that this list of neighbors is determined by the WTRU (mobile terminal). Zaki, Col. 2, lines 45-58. Within the WTRU 18 is a RSS/SNR measuring device 24 that measure the RSS and/or SNR of each BSS 12. Zaki, Col. 2, lines 52-53, Figure 3. Since the RSS/SNR measuring functionality resides in the WTRU 18 and which, apparently, provides the information to determine the BSS neighbor list, the only reasonable conclusion that can be drawn from the disclosure in Zaki is that the WTRU 18 does not receive the neighbor candidate list from an access point.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1-4 and 7-8.

III. REJECTION UNDER 35 U.S.C. § 103

Claims 5-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zaki (US Patent No. 7,164,915) in view of Astarabadi (US Patent Application Publication 2005/0138178). The rejection is respectfully traversed.

Noted above, independent Claim 5 has been amended to recite “wherein the roaming candidate list identifying the plurality of candidate access points in the WLAN is received from the first access point.” As established above, Zaki fails to disclose, teach or suggest this

element/feature. It does not appear that Astarabadi describes this claim element, and therefore, fails to cure the noted deficiency of Zaki.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 5-6.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

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